

### Remarks

#### The 102 (b) Rejections of Claims 1, 4, 6, 8, and 9

The Examiner has maintained the rejection of Claims 1, 4, 6, 8, and 9 under 35 U.S.C. §102 (b) as anticipated by United States Patent No. 5,139,476 to Peters (“Peters” or “the Peters patent”). Applicant respectfully traverses this rejection and requests reconsideration.

In the reply dated July 25, 2002 to the first Office Action (dated April 25, 2002), Applicant amended original Claim 1 to claim a laminated foam product in which the middle layer was comprised of compressed foam. The use of compressed foam is supported in the original specification in which a compression ratio of 4:1 was specified as a preferred compression ratio with a thickness of 0.155 inch. (See specification Page 3, lines 17-19.) Peters describes the foam core of the laminate used in the claimed knee wrap as between 0.1-0.3 inch. Therefore, Applicant’s claimed material comprises a foam core that is has four times as much material as that disclosed in Peters. Thus, Applicant traverses the Examiner’s interpretation of the term compressed as used in amended independent Claim 1. As stated in the Office Action dated November 5, 2003, the Examiner takes compression as a means to attenuate the foams density. A dictionary definition of the term “attenuate” is to thin or make thinner the density of the foam core. As amended, the claimed material actually possesses approximately four times as much foam material in the foam core.

“A claim is anticipated only if each and every element as set forth in the claims is found, either expressly or inherently described in a single prior art reference.” *Vandergaal Bros. v. Union Oil of California*, 814 F.2d 628, 631; 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). MPEP § 2131. (Emphasis added.). In order to anticipate Applicant’s independent Claim 1, the Peters patent must disclose all the elements of Applicant’s material as claimed in amended Claim 1. Peters makes no mention of the use of compressed foam in the middle layer of its disclosed material. Further, Peters makes no mention of a core having four times as much foam material in the core of the disclosed material as is found in Applicant’s material as claimed in Claim 1. Consequently, Peters fails to anticipate Applicant’s claimed material both because it fails to disclose any use of compressed foam in any quantity and because it fails to make any disclosure

of a laminated material with a foam core having the density of Applicant's claimed material. Applicant respectfully requests reconsideration.

In addition, in the Office Action of November 5, 2003, the Examiner states that "it is not seen what physical effect the compression step would have on the foam to distinguish it from the prior art (Peters). Applicant respectfully submits, as discussed below, that the Rule 132 affidavit submitted October 6, 2003 demonstrates the physical effect of the compressed foam on the stretch and recovery ( rebound value ) and porosity for the claimed material showing that the material claimed in Claim 1 is not the same material as disclosed in Peters.

Claims 4, 6, 8, and 9 depend from Claim 1 and thus incorporate all the elements of that claim. If a reference fails to anticipate a particular claim, it also fails to anticipate all the claims depending from that particular claim. Therefore, because Peters fails as a reference to anticipate Claim 1 under § 102 (b), it also fails to anticipate Claims 4, 6, 8, and 9. Applicant respectfully request reconsideration.

#### The § 103 (a) Rejections of claims 2 and 3

The Examiner has maintained the rejection of Claims 2 and 3 as unpatentable under 35 U.S.C. §103 (a) over Peters. Applicant respectfully traverses this rejection and requests reconsideration.

Applicant respectfully submits that Peters fails to make out a *prima facie* case of obviousness under § 103 (a) to reject Claims 2 and 3. To establish a *prima facie* case of obviousness there must be some suggestion or motivation to modify the reference. In this case Peters fails to suggest any type of modification of the open cell foam used in the central layer of the three layer laminate, let alone Applicant's specifically claimed core having compressed foam. In addition, in order to complete a *prima facie* case of obviousness, the reference must teach or suggest all limitations of the claim at issue. In this case, Peters fails to disclose the compressed foam claimed in Claim 1, from which claims 2 and 3 either directly or indirectly depend. Thus, Peters fails to disclose, teach, or suggest all the elements as claimed claims 2 and 3. In view of

the foregoing discussion, it is respectfully submitted that Peter fails to make out a *prima facie* case of obviousness under § 103 (a). Applicant courteously requests reconsideration and passage to allowance.

In addition, assuming *arguendo* that Peters does present a *prima facie* case of obviousness, which it does not, such a case can be overcome by presenting a factual finding demonstrating unexpected beneficial results. [ See MPEP § 716.02 (c) an *In re Soni*, 34 USPQ2d 1684 (Fed. Cir. 1995)] In this case, Applicant has presented a Rule 132 affidavit demonstrating that the claimed material, comprising a core of compressed foam, possesses a stretch and recovery (rebound value) property significantly improved over the rebound value properties of the Peters material. As stated in the Rule 132 Affidavit (“the affidavit”), not only does the claimed material possess a 22% greater recovery capability than the Peters material, it also was able to be stretched farther than the Peters material without breaking and still retain a significant rebound value. As seen in Graph 1 of the affidavit, at a stretched length of 127 mm, the Peters material ruptured, while the claimed material did not rupture even when stretched to a length of 152.4 mm. Such an unexpected increase in stretch and recovery is of benefit to users of the claimed material as it allows the same length and width of material to be stretched over a greater area on such items as medical braces, head gear and protective garments. This allows the user to save on the over all quantity of material he/she uses. Applicant respectfully submits that these unexpected results are within the scope of the claims as the unexpected results are found in Applicant’s claimed materials comprising the claimed compressed foam core.

#### The § 103 (a) Rejection of Claim 5

The Examiner has maintained the rejection of Claim 5 as unpatentable 35 U.S.C. § 103 (a) over Peters in view of United States Patent No. 5,399,306 to Follows, et al. (“Follows” or “the Follows patent”). Applicant respectfully traverses this rejection and requests reconsideration.

Claim 5 depends from Claim 1 and incorporates all the elements of that claim. As noted above, the Peters patent fails to disclose all the elements of Claim 5 in that it fails to disclose the

use of compressed foam in the disclosed laminated material. In addition, the disclosure in the Follows patent is limited to the mixture of various components with nylon yarn to produce luster. In fact, the disclosure and claims in Follows are specifically limited only to the production of a nylon yarn with no mention of applying the method of the Follows patent to foams in general or polyurethane in particular. Therefore, the combined references of Peters and Follows fail as a *prima facie* reference under § 103 (a) as first, they do not disclose each and every element of Claim 5 and second because there is no suggestion to combine the Peters and Follows patents to obtain Applicant's invention as claimed in Claim 5. Applicant respectfully submits that a person of ordinary skill in the art at the time the instant application was filed would not combine Peters, which fails to disclose the use of compressed foam in a laminate, with the disclosure in Follows which is limited not only just to yarn, but is specifically limited to nylon yarn. Applicant respectfully requests reconsideration and passage to allowance of Claim 5.

The § 103 (a) Rejection of Claims 10-12

The Examiner has maintained the rejection of Claims 10-12 as unpatentable under 35 U.S.C. §103 (a) over Peters in view of United States Patent No. 5,900,087 to Chakrabarti ("the '087 patent"). Applicant respectfully traverses this rejection and requests reconsideration.

In order to present a *prima facie* case of obviousness under 35 U.S.C. § 103 (a), the combined references must disclose each element of the claimed invention. Applicant courteously notes that claims 10-12 depend from amended Claim 1 and thus incorporate all the elements of that claim. As discussed above, Peters does not disclose the use of compressed foam in the middle layer of its laminate. In addition, the '087 patent also does not disclose a three layer laminate. Therefore, neither Peters nor the '087 patent disclose all the elements of Claims 10-12 in that they fail to disclose the use of compressed foam in a three layer laminate as is specifically claimed in Claim 1.

More importantly, the combined references fail as a references under § 103 (a) in that the '087 patent specifically limits the disclosed flame lamination technique to foams comprising diol or polyol moieties present within the polymer foam layer. This limitation of the disclosed

method, lacking in Applicant's claimed invention, is disclosed throughout the '087 patent as well as specifically claimed in Claim 1 of the '087 patent. See col. 2, lines 12-33 describing different groups of polymer with which the '087 method may be used, all of which have a polyol component. See also independent Claims 1 and 8 of the '087 patent in which the claimed process is limited to foams prepared with at least one diol. Therefore, the Peters - '087 patent combination fails as a combined reference under § 103 (a) as the flame lamination technique taught by the '087 patent is specifically limited to foams having a polyol and/or diol moiety. Applicant respectfully submits that a person of ordinary skill in the art would not combine the disclosure of the '087 with the Peters patent as the '087 patent limits the disclosed technique to polyol or diol containing foams not found in the inventions claimed in Claims 10-12. Applicant respectfully requests reconsideration and passage to allowance of Claims 10-12.

**Conclusion**

Applicant respectfully submits that the present application is now in condition for allowance, which action is courteously requested. The Examiner is invited and encouraged to contact the undersigned attorney of record if such contact will facilitate an efficient examination and allowance of the application.

Respectfully submitted,

*C. Richard Lohrman*  
C. Richard Lohrman  
Registration No. 46,878  
ATTORNEY FOR APPLICANT  
Simpson & Simpson PLLC  
5555 Main Street  
Williamsville, NY 14221  
Phone: (716) 626-1564  
Fax: (716) 626-0366

Dated: May 17, 2004